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Pearne & Gordon LLP

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Appl. No. 10/719,148
Amdt. Dated January 12, 2006
Reply to Office action of October 12, 2005

REMARKS/ARGUMENTS

Applicant would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe the subject matter which applicant regards as the invention.

Claims 1 and 8-11, 14-16 were rejected under 35 U.S.C. 102(b) as being anticipated by Haberlein et al. (U.S. Patent No. 6,109,251). Traversal of this rejection is made for at least the following reasons. Haberlein does not disclose a *crankshaft* supported for rotation within a crankcase *and* a *vibration mechanism* coupled to a portion of the crankcase, as recited in claim 1. The Examiner relies on crankshaft 5 of Haberlein as being equivalent to the claimed vibration mechanism. However, claim 1 requires that the four stroke engine include *both* a crankshaft *and* a vibration mechanism coupled to the crankcase. Further, it is noted that the Examiner conceded in an earlier action that "Haberlein et al does not disclose the means for vibrating the crankshaft includes a vibration mechanism coupled to a portion of the crankcase" (See page 3 of the Office action dated May 2, 2005).

Regarding claims 8, 9, 10, and 14, the Examiner contends that it is inherent in Haberlein that the clearance area 14 located in the crankcase 2 is less than 10 mm and about 1.5 mm, respectively. According to Section 2163.07(a) of the MPEP, "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (emphasis added). It is requested that the Examiner point out where in Haberlein it is made clear that the clearance area 14 must be less than 10 mm and is about 1.5 mm, as required by claims 8 and 9, respectively.

Because Haberlein does not disclose each and every limitation set forth in claims 1 and 8-11, 14-16, Haberlein cannot anticipate such claims. Withdrawal of this rejection and allowance of claims 1 and 8-11, 14-16 are respectfully requested.

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Claims 2, 3, 17 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Haberlein et al (U.S. Patent No. 6,109,251) in view of Mahn et al. (U.S. Patent No. 5,107,808). Traversal of this rejection is made for at least the following reasons. Claims 2 and 3 depend from claim 1, which is believed to be allowable over Haberlein for at least the reasons discussed above. Mahn does not make up for the deficiencies of Haberlein with respect to claim 1. Accordingly, the combination of Haberlein and Mahn does not render obvious claims 2 and 3. Claims 17 and 18 have been cancelled herein. Withdrawal of this rejection is respectfully requested.

Claims 5 and 7 were rejected under 35 U.S.C. 103(a) as being unpatentable over Haberlein in view of Okuda et al. (U.S. Patent No. 6,273,049). Traversal of this rejection is made for at least the following reasons. The Examiner concedes that Haberlein does not disclose that the vibration mechanism is a vibration plate. Thus, the Examiner relies on Okuda et al. in an attempt to make up for the deficiencies of Haberlein. However, the vibration plate 61 of Okuda is part of an experimental apparatus. It is requested that the Examiner explain why one skilled in the art would couple a vibration plate, which is used as part of an experimental apparatus to simulate normal engine vibrate, to a crankcase of a four stroke engine. As known to those skilled in the art, the engine of Haberlein is already producing the vibration that the simulator is simulating. There is nothing within Okuda that would teach or suggest adding a vibration plate to a crankcase provided within a four stroke engine.

Because neither Haberlein nor Okuda et al., alone or in combination, teach or suggest each and every limitation set forth in claims 5 and 7, the combination of Haberlein and Okuda et al. cannot render obvious such claims. Withdrawal of this rejection is respectfully requested.

Claim 6 was rejected under 35 U.S.C. 103(a) as being unpatentable over Haberlein et al. (U.S. Patent No. 6,109,251) in view of Okuda et al. (U.S. Patent No. 6,273,049). Traversal of this rejection is made for at least the following reasons. The Examiner concedes that the combination of Haberlein and Okuda et al. does not disclose a vibration mechanism being a vibration spring. The Examiner contends that it would have been obvious to modify Haberlein in view of Okuda et al. by employing a vibration spring in lieu of the vibration plate 61 of Okuda et al. First, this proposition requires a presumptive leap that the person of ordinary skill would even

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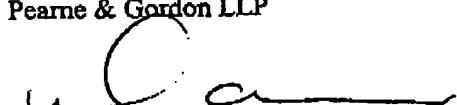
proceed as such. It is respectfully submitted that the Examiner has failed to uncover the claimed structure and has thus merely pronounced the structure to be a design choice. It is respectfully submitted that such an approach is not proper. Moreover, even assuming, *arguendo*, that this proposition was true, one skilled in the art would only be motivated to modify the experimental apparatus of Okuda et al. such that the apparatus for simulating normal engine vibration is a vibration spring. As discussed above, there is nothing within either Haberlein or Okuda et al. that provides motivation to couple an engine vibration simulator of an experimental apparatus to a crankcase of an engine.

For at least these reasons, the combination of Haberlein and Okuda et al. fails to teach or suggest a vibration spring to vibrate a crankcase of an engine, as required by claim 6. Withdrawal of this rejection is requested.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any fees resulting from this communication, please charge such fees to our Deposit Account No. 16-0820, Order No. 35703.

Respectfully submitted,
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January 12, 2006